

REMARKS/ARGUMENTS

Claims 1-6, 8-10, and 12-16 are amended by this response. No claims are canceled or added. Accordingly, following entry of these amendments and remarks, claims 1-16 will remain pending for examination.

Applicants first turn to address rejection of the claims based upon other than prior art. In particular, claims 1-5, 8, 9, 12, and 13 stand rejected under 35 U.S.C. §112 ¶2 as purportedly indefinite, and also stand rejected under 35 U.S.C. §101 for purportedly failing to set forth patentable subject matter.

As a threshold matter, the Examiner is respectfully reminded that:

[t]he primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or “technical” rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. (Emphasis added; MPEP 706.03)

Here, independent claims 1 and 8 formerly recited a "use". These independent claims have now been re-written as a method. Claims depending from independent claims 1 and 8 have similarly been amended to recite a method rather than a use. Based upon these amendments to the claims, it is respectfully asserted that the non-prior art claim rejections under 35 U.S.C. §112 and §101 have now been overcome.

Turning now to address rejection of the claims based upon prior art, Applicants note that certain claims stand rejected as anticipated, and not merely obvious, in view of alleged prior art:

[t]he distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. (Emphasis added; MPEP 706.02)

Here, claims 6, 7, and 14-16 were rejected under 35 U.S.C. §102(b) as being anticipated by Kizu et al., Chemical & Pharmaceutical Bulletin (1999) Vol. 47 No. 11, pp. 1618-1625 ("the Kizu Article"). These anticipation claim rejections are overcome as follows.

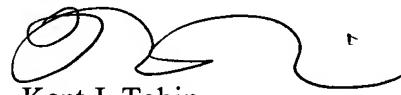
As noted by the Examiner in the latest office action, the Kizu Article describes a number of compositions having water as a carrier. However, claims 6 and 14-16 have now been amended to recite that the pharmaceutically acceptable carrier is not water. Because the Kizu Article fails to teach, or even suggest a method in which the pharmaceutical acceptable carrier is other than water, it is respectfully asserted that these claims cannot legitimately be considered anticipated by that reference. Accordingly, the anticipation claim rejections have been shown to be improper and should be withdrawn.

Claims 10 and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by Huang et al., Yaoxue Xuebao (2002), Vol. 37, No. 3, pages 199-203 ("the Huang Reference"). These anticipation claim rejections are overcome as follows.

The Huang Reference describes a composition having ethanol as a carrier. However, claim 10 has now been amended to recite that the pharmaceutically acceptable carrier is not ethanol. Because the Huang Reference fails to teach or suggest a method in which the pharmaceutical acceptable carrier is other than ethanol, it is respectfully asserted that claims 10-11 cannot legitimately be considered anticipated by that reference. Accordingly, the anticipation claim rejections have been shown to be improper and should be withdrawn.

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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